

 a backing;  
a support layer on the backing;  
a release layer on the support layer; and  
wherein the support layer and the release layer are deposited substantially simultaneously.

### **REMARKS**

Claims 6-8 and 10 have been cancelled. Claims 1 and 12 have been amended. Support for the amendments is found in the existing claims and the specification as discussed below. Accordingly, the amendments do not constitute the addition of new matter. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

The specific changes to the amended claims are shown on a separate set of pages attached hereto and entitled **VERSION WITH MARKINGS TO SHOW CHANGES MADE**, which follows the signature page of this Amendment. On this set of pages, insertions are underlined and deletions are struck through.

### **Personal Interview**

Applicants' representative would like to thank Examiners Brian Egan and Harold Pyon for the courtesy of a personal interview with Dan Altman and Connie Tong on January 6, 2003. During the interview, a graph prepared by Examiner Egan showing the results of Table 8 of the specification was discussed. Applicants provided arguments that the claimed invention was not obvious in view of the cited art. While not conceding that the claimed invention is *prima facie* obvious, the unexpected results obtained by the claimed invention would rebut any proper *prima facie* showing of obviousness. These unexpected results are explicitly recited within Claim 1.

### **Rejection under 35 U.S.C. § 112, first paragraph**

Claims 1, 4, and 10 are rejected under 35 U.S.C. § 112, first paragraph, for failing to contain a written description of the invention in such a full, clear, concise, and exact terminology as to enable any person skilled in the art to which it pertains to make and/or use the same.

This ground of rejection is moot in view of Applicants' cancellation of claim 10.

### **Rejection under 35 U.S.C. § 112, second paragraph**

Claims 1, and 9-10 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicants regard as their invention.

This ground of rejection is believed to be overcome by Applicants' amendment.

Withdrawal is respectfully requested.

Claims 6-8 and 13-14 are rejected under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention.

This ground of rejection is moot with regards to claims 6-8 which have been cancelled.

Regarding claims 13-14, the Examiner asserts that the limitation "wherein the 90 degree peel release force measured on a TLMI lab master instrument at a rate of 7.62 m/min is less than about 40 cN/25mm" is not a structure limitation. Applicants disagree. The peel force is a physical characteristic of the pressure sensitive adhesive label construction. Consequently, it relates to a structural feature and not to a method.

Reconsideration and withdrawal of this ground of rejection is respectfully requested.

Claim 12 is rejected under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention.

Claim 12 has been amended as suggested by the Examiner. Withdrawal of this ground of rejection is respectfully requested.

**Rejection under 35 U.S.C. § 103(a)**

Claims 1-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Patterson et al. in view of Allen et al, Ishiwata et al and Sasaki et al.

The Examiner asserts that Patterson et al. teach a multilayered release liner comprising a backing, a support layer covering the backing and a silicone-containing layer covering the support layer wherein the silicone layer has a release surface. Although the Examiner admits that Patterson et al. do not explicitly state that the silicone distribution at successive 1 micrometer depths from the release layer surface is overall substantially nonlinear to a total silicone content of at least 90% or that more than 70% of the silicone is within 2 micrometers from the release surface, the Examiner relies upon the teaching of Patterson et al. that both the deposition of the release coating and the support may be effected by conventional methods. The Examiner cites Allen et al., Ishiwata et al. and Sasaki et al. for their teachings on conventional coating methods,

particularly dual die coating, and asserts that one would be motivated to use dual die coating for the multilayered release liner of Patterson et al. because the dual die technique allows for thickness control of the layers and is cost effective.

The four factual inquiries for determination of obviousness are set forth in *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966) and are enunciated as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the art; and
- (D) Evaluating evidence of secondary considerations.

When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
  - (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
  - (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
  - (D) Reasonable expectation of success is the standard with which obviousness is determined.
- Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n. 5 229 U.S.P.Q. 182, 187 n. 5 (Fed. Cir. 1986).

In addition, secondary considerations such as unexpected results, must be considered in every case in which they are present and must be evaluated by the Examiner. See M.P.E.P. 2141.

***A prima facie case of obviousness has not been established***

As is well-known to the Examiner, *prima facie* obviousness requires that three criteria be met. First, the prior art reference or references must teach or suggest all claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings in a manner which renders the claimed invention obvious. Third, there must be some reasonable expectation of success of achieving the claimed invention when the references are combined in the manner being relied on for establishing obviousness. See MPEP section 2142. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on

applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d, 1438 (Fed. Cir. 1991). See M.P.E.P. section 2142.

In the present case, the prior art references do not teach or suggest all claim limitations, there is no suggestion or motivation to combine reference teachings and there is no reasonable expectation of success when the references are combined.

As described in the specification and set forth in the claims, the claimed invention is drawn to a substantially non-linear silicone distribution (see Table 8, present specification, page 28 and claim 1). Regarding claim 12 which is a product-by-process claim, as is well known to the Examiner, the patentability of a product-by-process claim does not reside in the process steps but rather in the characteristics of the product. See M.P.E.P. 2113. In the present case, the product of claim 12 has the same properties and characteristics as the product of claim 1. The non-linear silicone distribution of the release liners of Applicants' claimed invention are clearly different from the release liner of the prior art represented by Patterson et al. which teaches a linear distribution of silicone. Table 8 compares the release liner of the present invention, obtained by the method as recited in claim 12, with a release liner such as taught by Patterson et al. The substantially non-linear distribution as claimed by Applicants is clearly different from the linear distribution of silicone taught by Patterson et al. None of the cited references teach "a release surface wherein a lower amount of silicone is present in each successive 1  $\mu$ m depth from the release surface to the 1  $\mu$ m depth in which at least 50% of the total silicone in the silicone-containing layer is between that 1  $\mu$ m depth and the release surface" (claim 1). Thus, the cited references do not teach or suggest all claim limitations.

The Examiner asserts that Patterson et al. teach that the deposition of the release coating and the support may be effected by conventional methods (Paper No. 10, paragraph 8). Patterson et al. teach that the "deposition of the release coating may be effected by conventional methods. It may be applied, for instance neat or from a solvent, using such techniques as offset gravure, direct gravure or multiple roll." (Patterson, et al. col. 2, lines 53-59). However, Patterson et al. neither teach nor suggest a method where the "support layer and release layer are deposited substantially simultaneously" (claim 12). That is, there is no teaching or suggestion in Patterson et al. or in any of the cited references to use a dual die coating method to achieve a release liner with a silicone and a support layer. There is no teaching or suggestion in Patterson et al or any of the cited references that would lead one of ordinary skill in the art to combine the references to

achieve the claimed invention. While the secondary references disclose multilayer coating methods, there is no teaching or suggestion to combine the secondary references with the teaching of Patterson et al. Furthermore, there was no reasonable expectation that by combining the teaching of Patterson, et al. with any of the other cited references, a release liner with a substantially non-linear gradient of silicone and with most of the silicone towards the release surface would be achieved. There is nothing in the combination of references that would lead one of ordinary skill in the art to expect the non-linear gradient of silicone which is an element of the claimed invention.

***Even if a prima facie case of obviousness had been established, the cited combination of references would not render obvious the claimed invention***

Once a *prima facie* case of obviousness has been made by the PTO (and Applicants maintain that it has not), the burden is upon Applicants to produce contrary evidence. See *In re Hoeksema*, 399 F.2d 274-275, 158 U.S.P.Q. 601 (CCPA 1968). A well-known tenet of patent law is that evidence of unexpected results can rebut a *prima facie* case of obviousness. See M.P.E.P. Section 716.02(a). "Usually, a showing of unexpected results is sufficient to overcome a *prima facie* case of obviousness" see M.P.E.P. at 2144.08 citing *In re Albrecht*, 514 F.2d 1389, 1396, 185 U.S.P.Q. 585, 590 (CCPA 1975).

As set forth in the specification, one advantage of the claimed multilayer release liners is that the amount of silicone used is minimized as a higher proportion of the silicone is near the release layer surface. This is due to the non-linear gradient of silicone in the multilayer release liner constructs taught by Applicants. In contrast to the release liner of Patterson et al., the multilayer release liner claimed by Applicants has a non-linear distribution with proportionally more silicone near the release layer surface as shown in Table 8 which compares the amount of silicone at various depth levels with the amount of silicone in the release liners prepared by the method as described by Patterson et al. This result provides a clear advantage over the prior art as the amount of expensive silicone required is minimized. This result could not have been expected based upon the cited references.

In view of Applicants' amendments and arguments, reconsideration and withdrawal of this ground of rejection is respectfully requested.

Claims 13-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Patterson et al in view of Allen et al., Ishiwata et al, and Sasaki et al. and further in view of Newing et al.

The Examiner cites Newing et al for their teaching on a peel release force below 20 cN/25mm. However, there is no teaching in Newing et al or any of the cited references on a silicone layer having a release surface wherein the silicone distribution at successive 1 micrometer depths from the release surface is overall substantially nonlinear to a total silicone content of at least 50%. There is nothing in the cited references, alone or in combination, that would lead one of ordinary skill in the art to the multilayer release layer as claimed either with or without a peel release force below 20 cN/25mm. Newing et al. does not correct the deficiencies of the references discussed above.

In view of Applicants amendment and arguments, reconsideration and withdrawal of this ground of rejection is respectfully requested.

### **CONCLUSION**

In view of Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated:

Jan. 13, 2003

By:

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**Claims 1 and 12 have been amended as follows:**

Claim 1. (Amended) A multilayer release liner, comprising:

a backing;

a support layer covering the backing;

a silicone-containing layer covering the support layer, the silicone layer having a release surface; and

~~wherein the silicone distribution at successive 1 micrometer depths from the release layer surface is overall substantially nonlinear to a total silicone content of at least 50%~~wherein a lower amount of silicone is present in each successive 1  $\mu$ m depth from the release surface to the 1  $\mu$ m depth in which at least 50% of the total silicone in the silicone-containing layer is between that 1  $\mu$ m depth and the release surface.

Claim 12. (Amended) A pressure-sensitive adhesive label construction incorporating the ~~multilayer release liner of Claim 6~~a multilayer release liner comprising:

a backing;

a support layer on the backing;

a release layer on the support layer; and

wherein the support layer and the release layer are deposited substantially simultaneously.